



Application No. 10/035,783

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Attorney Docket No.: 1016US

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*Debra K. Bowen*

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Graupe, et al.

Application No.: 10/035,783

Group Art Unit: 1626

Filed: 12/24/01

Examiner: Shiao, R.

Title: NOVEL COMPOUNDS AND COMPOSITIONS AS  
CATHEPSIN INHIBITORS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE**

This reply is filed in response to an Office Action mailed June 11, 2003, for which a response is due on September 11, 2003. Enclosed under separate cover is a Petition from Requirement for Restriction under 37 C.F.R. § 1.144 (2003). Applicants herein request cancellation of Claim 30 and reconsideration of the Requirement for Restriction.

**PROCEDURAL HISTORY**

In an Office Action mailed November 6, 2002, the Examiner required the Applicants to elect one of the following three groups:

- I. Claims 8-9, 13-15 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in

part, drawn to methods of making; Class 558, subclass various, wherein  $X^1$ ,  $R^3$  and  $R^4$  are non-heterocyclic.

- II. Claims 10-12, 16-18, 19-21, 22-24 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein  $X^1$ ,  $R^3$  and  $R^4$  are heterocyclic.
- III. Claims 25-27 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein  $X^1$ ,  $R^3$  and  $R^4$  are heterocyclic.
- IV. Claims 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein  $X^1$ ,  $R^3$  and  $R^4$  comprise compounds not encompassed by Groups I, II or III.

The Applicants further were required to elect a single disclosed species for examination. In a response dated May 5, 2003 the Applicants elected Group II and the species disclosed on page 546, line 9 and 10, of the specification having the following structure:

